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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David Leigh Donoho

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT

PAPER NUMBER

2445

MAIL DATE

DELIVERY MODE

01/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/782,011	DONOHO ET AL.	
	Examiner	Art Unit	
	AZIZUL CHOUDHURY	2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7,9-12,21-28 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) 1,5,21-28 and 35-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/13/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the amendment of the applicant, received on September 29, 2008.

Election/Restrictions

Claims 1, 5, 21-28 and 35-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions I and III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 10, 2008.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7 and 9-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 25 and 30 of U.S. Patent No. 6,263,362. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claimed invention and the patented invention claim computer property inspecting system employing relevance language (an extensible and non-procedural language) and mathematico-logical calculations. While the patented invention does not claim the prevention of divulging the user's identity, it does describe such a feature within the specifications and it is well known in the art that personal information can be protected from network management systems.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hemphill (US Patent No: 6,167,448) in view of Ahmad (US Patent No: 6,029,258).

1. Regarding claim 7, Hemphill further discloses through Ahmad, a computer implemented inspector for inspecting any of the properties of a computer, said computer's configuration, contents of said computer's storage devices, said computer's

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peripherals, said computer's environment, or remote affiliated computers, said inspector comprising: an inspector library containing code written in an extensible and non-procedural language using no function calls with variable arguments [Hemphill, column 1, lines 40-48], which is invoked as part of a continual relevance evaluation process, executing on said consumer's computer [Hemphill, column 1, lines 33-51 and]; wherein said inspector is configured to automatically and without receiving consumer's input query at least one physical device communicatively coupled to said consumer's computer, in order to glean property information concerning said consumer's computer, wherein said inspector does not inspect a printer of said computer's peripherals [Hemphill, column 4, lines 6-57]; one or more automatic unattended inspector methods for performing any of mathematic-logical calculations, executing computational algorithms, returning the results of system calls, accessing the contents of storage devices, and querying devices or remote computers [Hemphill, column 4, lines 58-65], wherein a one way membrane allows said inspector methods to view a relevant advisory without divulging user's identity

While Hemphill's disclosure teaches network monitoring systems detecting network device properties, it does not explicitly teach automatically monitoring nor does it teach keeping the user's identity confidential. In the same field of endeavor, Ahmad teaches how troubleshooting can be performed automatically; col. 13, lines 9-12, Ahmad. Plus Ahmad teaches a system that monitors remote devices; column 5, lines 20-43 and column 13, lines 40-55, Ahmad. Plus Ahmad teaches how user identity is not obtained from the user's machine; see Ahmad, col. 7, line 69 – col. 8, line 26 and

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col. 10, lines 30-43. The automatic and confidential monitoring of networked devices is useful in allowing others to resolve device issues. Therefore, it would have been obvious to one skilled in the art, during the time of the invention to combine the teachings of Hemphill with those of Ahmad, to provide a system for automatically and adaptively monitor and resolve network device problems [column 5, lines 20-43, column 13, lines 40-55 and col. 13, lines 9-12, Ahmad].

2. Regarding claim 9, Hemphill further discloses through Ahmad, sending certain relevance clauses to a remote location; evaluating the clauses; and returning the clauses after a user is made aware of what is being transferred; wherein properties of the remote location are learned [see column 13, line 62 – column 14, line 6 and Ahmad, col. 6, lines 36-67 and col. 9, lines 44-63].

3. Regarding claim 10, Hemphill discloses through Ahmad the apparatus wherein properties which can be learned are an arbitrary combination of elementary properties that are determined according to basic calculations [see column 13, line 62 - column 14, line 6, Hemphill and Ahmad, col. 6, lines 36-67 and col. 9, lines 44-63].

4. Regarding claim 11, Hemphill discloses through Ahmad the said inspector library further comprising any of: a declaration of a Phrase to be used in a relevance language; an association of said Phrase to a specific method; a declaration of a new data type to be used in an evaluation process; a declaration of a calling prototype of

said specific method, including a number and required data types of arguments to be supplied to said specific method; a declaration of a result data type of said specific method; an implementation of said specific method in executable form; a declaration of special hooks associating code to be called on events; a declaration of special hooks associated with creation and maintenance of special caches associated with said specific method; and an implementation of special event methods and cache methods in executable form [see column 1, lines 53-65, Hemphill].

5. The obviousness motivation applied to claim 7 is applicable to its respective dependent claims.

Response to Arguments

Applicant's arguments with respect to claims 7 and 9-12 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1, 5, 21-28 and 35-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions I and III. Thus only claims 7 and 9-12 remain for examination. Claims 7 and 9-12 have been rejected under nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 25 and 30 of U.S. Patent No. 6,263,362. And claims 7 and 9-11 now stand rejected under the new 103-type rejection under Hemphill in view of Ahmad.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AZIZUL CHOUDHURY whose telephone number is (571)272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrice Winder/
Primary Examiner, Art Unit 2445

/A. C./
Examiner, Art Unit 2445